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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,869	05/13/2003	Nicholas Luke Bennett	007051.P016	6312

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EXAMINER	
NGUYEN, DAT	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/856,869	BENNETT ET AL.	
	Examiner	Art Unit	
	DAT T. NGUYEN	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-12,18,19,23-51,55-62,79,83,84,89,90,92-96,100-102,106-108,111,112,125,129,139-149,154-156,161-165 and 168-198.

Continuation of Disposition of Claims: Claims rejected are 1-12,18,19,23-51,55-62,79,83,84,89,90,92-96,100-102,106-108,111,112,125,129,139-149,154-156,161-165 and 168-198.

DETAILED ACTION

Response to Amendment

This office action is responsive to amendments filed on 01/03/2008 in which applicant amends claims 1, 5, 6, 7, 8, 42, 46, 118, 119, 120, 154, 164, 165, 171, 195 and 196 and responds to claim rejections. Claims 1-12, 18, 19, 23-51, 55-62, 79, 83, 84, 89-90, 92-96, 100-102, 106-108, 111, 112, 125, 129, 139, 140-149, 154-156, 161-165 and 168-198 are pending.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 09/092,901. Although the conflicting claims are not identical, they are not patentably distinct from each other because at least independent claims 1 teaches the same subject matter taught in claims 1 and 15 of copending Application No. 09/092,901 in broader scope by eliminating the limitation displaying a game image of a hybrid game comprising one or more rotatable reels of a spinning reel game, the spinning reel and pin and ball games each potentially contributing to a single game outcome.

Claims 1-12, 18-19, 23-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-122, 125, 129, 139, 140-149, 154-156, 161-165, 168-198 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-162 of copending Application No. 10/110,289. Although the conflicting claims are not identical, they are not patentably distinct from each other because at least independent claims 1 discloses the same subject matter taught in claims 1 and 150 of copending Application No. 10/110,289 in broader scope by eliminating the limitation a variable value bonus prize is awarded when a predetermined triggering event occurs,

the value of the bonus prize for a future instance of the bonus prize award being altered in response to the occurrence of a predetermined prize altering event in respect of a current instance of the game.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 9-12, 18, 19, 23-51, 55-62, 79, 83, 84, 89-90, 92-96, 100-102, 106-108, 111, 112, 125, 129, 139, 140-149, 154-156, 161-165 and 168-198 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa (US 5,836,819) in view of Ugawa (US 5,509,655).

Claim 1. Ugawa'819 teaches an electronic gaming console having credit means, reward means, game control means, display means, and player input controls, the control means being responsive to the credit means and the player input controls to play a game which is displayed on the display means and if a winning event occurs, a player reward is awarded by the reward means, the gaming console being characterized in that the game provides a video display of a labyrinth of pins and the player input controls allow the player to initiate the motion of ball images on the display, player

rewards being awarded when the ball images come to rest in predetermined prize winning locations (Figs. 1-3; col. 33:62-34:12).

Ugawa'819 fails to meet the claimed limitation of allowing the player to initiate firing of ball games on the display and to control firing parameters for the ball images. In a related patent Ugawa'655 teaches such a limitation in the form of inputting wagers (4:10-40, 5:20-35 and 6:10-17). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to implement the player initiated firing and controlling means of Ugawa'655 in order to allow players a small level of control or perceived control over the game whereby increasing player interest and excitement.

Claims 2-4. Ugawa'819 teaches controlling firing speed, firing direction and trajectory of the ball (Fig. 2; col. 4:25-5:34 and col. 37:12-23).

Claim 5. Ugawa'819 teaches wherein the number of balls provided to a player for a game is dependent upon a number of credits bet on the game (col. 16:60-17:10).

Claims 18-19. Ugawa'819 teaches the number dropped is variable from game to game and is selectable by the player (col. 13:9-35 and col. 16:51-17:34).

Claims 118-122, 147. Ugawa'819 teaches providing a plurality of targets and awarding assigned to the targets such that if a ball comes to rest in or pass through predetermined prize winning target positions and the prize winning locations are cups (Figs. 1-3).

Claim 149. Ugawa'819 teaches providing a plurality of ball types (Fig. 41).

Claim 168. Ugawa'819 teaches the path of the ball is affected by an object which moves the ball sideways or upward (Fig. 2).

Claim 171. Ugawa'819 teaches incorporating a further type of game into the base game (Figs. 1-3).

Claim 172. Ugawa'819 teaches the further game is provided as a feature game associated with the base game (the slot game and pachinko games constitute "feature" game).

Claim 173. Ugawa'819 teaches the feature game is a spinning reel game (Figs. 2, 38a-c).

Claim 176. Ugawa'819 teaches the feature game is a card game (i.e. the spinning reels display playing card indicia).

Claim 177. Ugawa'819 teaches the feature game is a second screen animation (i.e. the slot game is an animation in a second screen from the pachinko game).

Claims 178. Ugawa'819 teaches the feature game is a wheel game (Fig. 1). Slot reels are wheel games.

Claim 179. Ugawa'819 teaches the game feature is awarded from the base game in response to a predetermined trigger (Fig. 55A). the slot game and pachinko games are awarded to the player in response to the trigger of inserting coins into the device (col. 17:17-34).

Claim 180. Ugawa'819 teaches the feature game triggers another base game feature (Fig. 2). The pachinko game triggers the card game feature (Figs. 28A, 28B).

Claims 181-183. Ugawa'819 teaches the feature game is played in conjunction with the base game (Fig. 2).

Claim 184. Ugawa'819 teaches the feature game is an independent game and where a predetermined trigger condition or award causes the feature game to run, and if a winning condition is achieved in the feature game, the feature game reveals a bonus condition (Figs. 1-2, 28A, 28B, 55B; col. 33:62-34:12).

Claim 185. Ugawa'819 teaches the bonus condition is an award of a prize (Figs. 28A, 28B).

Claim 186. Ugawa'819 teaches the bonus condition is a win multiplier (Fig 55B (S58, S63)).

Claim 187. Ugawa'819 teaches the bonus condition id a number of free game.

Claim 190. Ugawa'819 teaches the trigger condition to run the feature game is achieved by the collection of balls in a predetermined container (col. 11:35-64).

Claims 9-12. Ugawa'819 teaches providing balls of different colors (Fig. 41; col. 27:41-51). Further, assigning prize values to the balls according to the colors of the balls and changing color of the ball as it dropped would have obvious matter of design choice according to a game designer's preference.

Claims 23-28. Ugawa'819 teaches the number of balls to be purchased is varied (col. 16:60-17:10) and the unpurchased balls are distinguished from the purchased balls by appearance (col. 13:9-17). Further, displaying different objects in different colors, transparent, etc. to distinguish the objects from each other would have been well-known and obvious matter of design choice.

Claims 29-46. Ugawa'819 teaches associating functions or characteristics with the balls and selecting type of the ball to be played in the game (col. 27:41-51 and col.

28:31-36). Further, plotting paths of the balls when it dropped, setting criteria to obtain bonus prize would have been obvious design choice and requires only routine skill in the art.

Claim 47. Ugawa'819 mentioned the known feature that some wins are paid in balls rather than credits (col. 2:49-59).

Claims 48-51, 55-62, 79, 83-84, 89-90, 92-96, 100-102, 106-108, 111-117, 122, 125, 129, 139-146, 148, 161-165, 169-170, 174, 175, 188-189, 191-198. awarding particular prizes when a trigger event occurs or a winning condition is met, using different sizes of the balls to be played in a pin ball game, setting particular characteristics of the balls and pins when the balls strike the pins, playing a keno game, bingo game in the gaming machine, player selects a game, etc. would have would have been obvious design choice according to the desires of the game designer.

Regarding claims 154-156, the prior art fails to teach the limitations of augmenting payout based on wager amount, however such a limitation is notoriously old and well known. Therefore it would have been obvious to one of ordinary skill in the art to increase payout as the player's bet increases, such a feature would entice players to bet more for the prospect of a better reward whereby increasing revenue for machine operators.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa (US 5,836,819) in view of Ugawa (US 5,509,655) and further in view of Kortenhaus (US 3,807,541).

The prior art fails to teach the limitations of providing discount credits wherein more credits can be provided for the same value of payment at different times. Kortenhaus teaches providing players with discount credits wherein a player may receive more credits for the same amount of input in subsequent plays of the game (6:10-35, feature 38, conversion device). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to offer players game discounts for subsequent play to promote continued activity at the game machine whereby generating more income for the operators.

Response to Arguments

Applicant's arguments filed 01/03/2008 have been fully considered but they are not persuasive.

Applicant alleges that the color change of the balls is not a design choice. The examiner respectfully disagrees. If there is any benefit to be offered, they would not be new or unobvious benefits such as the changing of colors of balls to increase player interest and excitement since it is well known that colors can be used to attract players. Such an aesthetic feature is merely a matter of design choice. Furthermore, the claims merely recite the change of colors of the balls and pins.

Regarding claim 23, the use of colors or display settings to distinguish a purchased ball from an unpurchased ball is akin to the use of colors in the argument above and interpreted as mere matters of design choice.

Regarding varying aspects and physics of the ball, such an augmentation is merely a matter of design choice as the examiner does not believe that they would add

any unobvious or novel benefit that would not be known and well understood to one of ordinary skill in the art an therefore would be a mere matter of aesthetic and design choice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 06023132 A, issued to Takeuchi et al. teaches the use of illumination of the balls with different colors (different colored balls).

JP 05076649 A, issued to Harigai teaches the use of different colored balls for different scoring methods.

JP 09234276 A, issued to Takeuchi et al. teaches the use of different displays and illumination and color settings.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAT T. NGUYEN whose telephone number is (571)272-2178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

Dat Nguyen